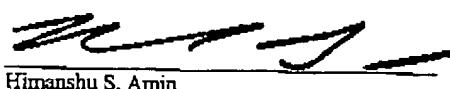


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CERTIFICATE OF FACSIMILE TRANSMISSION

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Date: 1-20-05


Himanshu S. Amin

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): Nainesh P. Shah

Examiner: Daniel St. Cyr

Serial No: 10/017,655

Art Unit: 2876

Filing Date: December 6, 2001

Title: GOOD READ INDICATOR FOR HYBRID CODE READER

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

Applicant's representative submits this brief in connection with an appeal of the above-identified patent application. A credit card payment form is filed concurrently herewith in connection with all fees due regarding this appeal brief. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [TELNP217USA].

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I. Real Party in Interest (37 C.F.R. §41.37(c)(1)(i))

The real party in interest in the present appeal is Symbol Technologies, Inc., the assignee of the present application.

II. Related Appeals and Interferences (37 C.F.R. §41.37(c)(1)(ii))

Appellant, appellant's legal representative, and/or the assignee of the present application are not aware of any appeals or interferences which may be related to, will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims (37 C.F.R. §41.37(c)(1)(iii))

Claim 11 has been cancelled. Claims 1-10 and 12-22 stand rejected by the Examiner. The rejection of claims 1-10 and 12-22 is being appealed.

IV. Status of Amendments (37 C.F.R. §41.37(c)(1)(iv))

No claim amendments have been entered after the Final Office Action.

V. Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(1)(v))**A. Independent Claim 1**

Independent claim 1 recites an image collecting module, comprising: a first multicolor photo indicator to provide an indication of a valid read of a first portion of a hybrid dataform; and a second indicator to provide an indication of a valid read of a second portion of the hybrid dataform. (See e.g., page 2, lines 19-30 and page 5, lines 15-20).

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B. Independent Claim 13

Independent claim 13 recites a method of providing indication of a valid read by an image collecting module, comprising: reading in a first portion of a hybrid dataform; determining if the first portion is valid; reading in a second portion of the hybrid dataform; determining if the second portion is valid; and providing the indication in the form of a photo signal if the first and second portion are valid. (See e.g., Fig. 3, and page 9, lines 6-23).

C. Independent Claim 20

Independent claim 20 recites an image collecting system, comprising: means for determining a valid read of a first portion of a hybrid dataform. (See e.g., page 2, lines 23-26). Independent claim 20 also provides means for determining a valid read of a second portion of a hybrid dataform. (See e.g., page 2, lines 26-27). In addition, independent claim 20 discloses means for enabling an illumination indicator if the first portion of the hybrid dataform is valid. (See e.g., page 2, lines 28-29). Further, independent claim 20 recites means for disabling the illumination indicator if the second portion of the hybrid dataform is valid. (See e.g., page 3, lines 9-11).

The means for elements described above are identified as elements subject to the provisions of 36 U.S.C. §112 ¶6. The structures corresponding to these elements are identified with reference to the specification and drawings in the above-noted parentheticals.

D. Independent Claim 21

Independent claim 21 recites an image collecting module, comprising: a vibration system for indicating the read status of a hybrid dataform, the system including; a first vibration indicator to provide an indication of a valid read of a first portion of the hybrid dataform, the first vibration indicator being an on state of the vibration system; and a second vibration indicator to provide an indication of a valid read of a second portion of the hybrid dataform, the second vibration indicator being an off state of the vibration system; wherein the vibration system vibrates upon the valid read of the first

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portion and remains on until the valid read of the second portion. (See e.g., page 3, lines 21-24).

E. Independent Claim 22

Independent claim 22 recites a portable image collecting module, comprising: a first indicator to provide an indication of a valid read of a first portion of a hybrid dataform; and a second indicator to provide an indication of a valid read of a second portion of the hybrid dataform; wherein the first indicator and the second indicator each in the form of one of an audio signal, a photo signal, and a vibration signal. (See e.g., page 2, lines 19-30).

VI. Grounds of Rejection to be Reviewed (37 C.F.R. §41.37(c)(1)(vi))

A. Claims 1-10 and 12-22 are unpatentable under 35 U.S.C. §103(a) over Li et al. (US 5,672,858), in view of Clark et al. (US RE37,635).

VII. Argument (37 C.F.R. §41.37(c)(1)(vii))

A. Rejection of Claims 1-10 and 12-22 Under 35 U.S.C. §103(a)

Claims 1-10 and 12-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Li *et al.* (US 5,672,858), in view of Clark *et al.* (US RE37,635). Reversal of this rejection is respectfully requested for at least the following reasons. The combination of Li *et al.* and Clark *et al.* fails to teach or suggest each and every element set forth in the subject claims.

i. Li et al. and Clark et al., either alone or in combination, fails to teach or suggest all elements set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to

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one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Applicant's claimed invention relates to a portable image collecting module operable to read one-dimensional, two-dimensional and hybrid dataforms. The image collecting module comprises an indicator system and method that provides a user with indication of either a valid read, or an invalid read of: one-dimensional, two-dimensional and hybrid dataforms. Independent claim 1 (and associated dependent claims) recites: *a first multicolor photo indicator* to provide an indication of a valid read of a first portion of a hybrid dataform; and a second indicator to provide an indication of a valid read of a second portion of the hybrid dataform. Further, independent claims 13 and 20, and claims that depend there from, respectively recite a method and a means for effectuating the invention. It is apparent that the claimed invention utilizes a first *multicolor photo indicator* to apprise a user of the validity, or invalidity of, a first portion of a hybrid dataform by the image collecting module. *Li et al.* and *Clark et al.*, either alone or in combination, fail to teach or suggest this exemplary aspect of the claimed invention.

In the Final Office Action (dated August 9, 2004), the Examiner conceded that *Li et al.* failed to provide the user, through the utilization of a first multicolor photo indicator, an indication that a hybrid dataform has been successfully read. Thus, in an attempt to rectify this deficiency, the Examiner offered *Clark et al.* as providing the necessary teaching or suggestion to satisfy the Examiner's burden under 35 U.S.C. §103(a). The Examiner in particular indicated that support could be found at col. 3, line 65-col. 4, line 4, of *Clark et al.* Applicant's representative in response noted that the passage cited, rather than providing a first multicolor photo indicator to apprise the user of a successful read of a hybrid dataform, provided a single *monochromatic* light emitting diode to indicate to an operator that a bar code symbol has been successfully decoded.

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In addition, to further substantiate the assertion that Clark *et al.* renders obvious applicant's claimed invention, the Examiner, in the Response to Arguments section of the Final Office Action (dated August 9, 2004), provided Leister (US 5,196,686), col. 2, lines 37-52, as disclosing a LED capable of being a multicolor indicator. However, as was stated by applicant's representative in the Reply to the Final Office Action, and is reiterated herein, Leister utilizes a *pair of indicator lights*, not a single *multicolor photo indicator* to provide an indication of a valid read of a first portion of a hybrid dataform, as is recited in the subject claims. It is therefore apparent that Leister does not teach or suggest the first multicolor photo indicator of the subject claims, but instead provides two separate and distinct lights to indicate whether or not a good or bad read has taken place. It is thus submitted that Leister fails to provide the evidentiary substantiation for which the Examiner cites the document.

With respect to independent claims 21 and 22, which recite the utilization of audio, visual, and vibration signals to indicate the read status of hybrid dataforms. The Examiner in the Final Office Action (dated August 9, 2004) rejected these claims out of hand, claiming that the use of sound/vibration indication means are functionally equivalent to a LED means, and therefore would by extension have been obvious in view of Li *et al.* As was stated in the Reply to Final Office Action, applicant's representative contends that the Examiner is conflating the distinctions between human sensory perceptions, i.e., sight, smell, sound, taste and touch, in order to obfuscate the novelty of applicant's claimed invention, and thus has embarked on an exercise in sophism. Further, the Examiner is reminded that in order to establish obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest all the claim elements. *See MPEP §706.02(j).* In view of the fact that the Examiner is unable and/or unwilling to elucidate substantive evidentiary support within the documents provided, but instead resorts to the utilization of functional equivalents, is a clear indication that the cited documents are devoid of the necessary teaching or suggestion to ground an appropriate rejection under 35 U.S.C. §103.

Moreover, the Examiner is further counseled that an additional requirement for an obviousness rejection under 35 U.S.C. §103, is that the teaching or suggestion must be found within the prior art and not in the applicant's disclosure. *See e.g., In re Vaeck*, 947

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F.2d 488 (Fed. Cir. 1991). In light of the fact that the Examiner has been unable to locate documents that directly or indirectly teach or suggest the utilization of tactile, audio and/or visual stimuli to indicate the appropriate read status of a hybrid dataform, and further in view of the Examiner's own admission that Li *et al.* fails to disclose or fairly suggest that the indication means of the reader are LEDs (i.e. photo, illumination, lights) or vibration signals for indicating a valid read, it is incomprehensible to applicant's representative's mind how the use of sound/vibration indicating means can be functionally equivalent to an entity that the Examiner concedes is not disclosed in the cited documents. It is thus submitted, since Li *et al.* fails to fairly teach or suggest a LED means, the Examiner is impermissibly attempting to utilize applicant's specification as a 20/20 hindsight-based roadmap to achieve the purported combination; an exercise that the Court of Appeals for the Federal Circuit has condemned. *See e.g., Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

In view of at least the foregoing, and since neither Li *et al.* nor Clark *et al.*, either individually or in combination, contemplate the invention in its entirety as set forth in the subject claims, it is requested that the rejection of independent claims 1, 13, 20, 21 and 22, and associated dependent claims, be withdrawn.

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B. Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 1-10 and 12-22 be reversed.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,
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10/017,655T148**VIII. Claims Appendix (37 C.F.R. §41.37(c)(1)(viii))**

1. An image collecting module, comprising:
 - a first multicolor photo indicator to provide an indication of a valid read of a first portion of a hybrid dataform; and
 - a second indicator to provide an indication of a valid read of a second portion of the hybrid dataform.
2. The module of claim 1, further comprising a processor to provide activation of the first multicolor photo indicator and the second indicator upon a valid read of the respective portions of the dataform.
3. The module of claim 1, the first multicolor photo indicator being a first LED and the second indicator being a second LED.
4. The module of claim 3, the first LED flashing a first color upon a valid read of the first portion and flashing a second color upon an invalid read of the first portion, and the second LED flashing the first color upon a valid read of the second portion and flashing the second color upon an invalid read of the second portion.
5. The module of claim 3, the first LED illuminating upon a valid read of the first portion, and the second LED flashing and the first LED turning off upon a valid read of the second portion.
6. The module of claim 1, the first multicolor photo indicator being an on state of a LED and the second indicator being an off state of the LED wherein the LED illuminates upon a valid read of the first portion and remains on until a valid read of the second portion.
7. The module of claim 6, the LED flashing red for an invalid read of one of the first portion and the second portion.

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8. The module of claim 1, the first multicolor photo indicator being a first LED signal and the second indicator being a first audible signal.

9. The module of claim 8, further comprising a second audible indicator generating a second audible signal, the first audible signal having a different tone than the second audible signal.

10. The module of claim 1, the second indicator being an audible indicator representative of an on state of an audible system and the second indicator being an audible signal of an off state of the audible system, wherein the audible system stays on upon the valid read of the first portion and remains on until the valid read of the second portion.

11. (Cancelled)

12. The module of claim 1, further comprising a selection switch for selecting between reading dataforms of a one-dimensional type, a two-dimensional type and a hybrid type.

13. A method of providing indication of a valid read by an image collecting module, comprising:

reading in a first portion of a hybrid dataform;
determining if the first portion is valid;
reading in a second portion of the hybrid dataform;
determining if the second portion is valid; and
providing the indication in the form of a photo signal if the first and second portion are valid.

14. The method of claim 13, wherein providing the indication if the first and second portion are valid comprises providing a first indication if the first portion is valid and providing a second indication if the second portion is valid.

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15. The method of claim 14, wherein providing the first indication comprises flashing a first LED for a valid read of the first portion and providing the second indication comprises flashing a second LED for a valid read of the second portion.

16. The method of claim 14, further comprising providing an error indication if an invalid read occurs for one of the first portion and the second portion.

17. The method of claim 14, wherein providing the first indication comprises providing a first audible tone for a valid read of the first portion and providing the second indication comprises providing a second audible tone for a valid read of the second portion.

18. The method of claim 14, wherein providing the first indication comprises activating an audible tone for a valid read of the first portion and providing the second indication comprises deactivating the audible tone for a valid read of the second portion.

19. The method of claim 14, wherein providing the first indication comprises activating a vibration system for a valid read of the first portion and providing the second indication comprises deactivating the vibration system for a valid read of the second portion.

20. An image collecting system, comprising:
means for determining a valid read of a first portion of a hybrid dataform;
means for determining a valid read of a second portion of a hybrid dataform;
means for enabling an illumination indicator if the first portion of the hybrid dataform is valid; and
means for disabling the illumination indicator if the second portion of the hybrid dataform is valid.

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21. An image collecting module, comprising:

a vibration system for indicating the read status of a hybrid dataform, the system including;

 a first vibration indicator to provide an indication of a valid read of a first portion of the hybrid dataform, the first vibration indicator being an on state of the vibration system; and

 a second vibration indicator to provide an indication of a valid read of a second portion of the hybrid dataform, the second vibration indicator being an off state of the vibration system;

 wherein the vibration system vibrates upon the valid read of the first portion and remains on until the valid read of the second portion.

22. A portable image collecting module, comprising:

 a first indicator to provide an indication of a valid read of a first portion of a hybrid dataform; and

 a second indicator to provide an indication of a valid read of a second portion of the hybrid dataform;

 wherein the first indicator and the second indicator each in the form of one of an audio signal, a photo signal, and a vibration signal.

IX. Evidence Appendix (37 C.F.R. §41.37(c)(1)(ix))

None.

X. Related Proceedings Appendix (37 C.F.R. §41.37(c)(1)(x))

None.